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PATENT APPLICATION
Do. No. 4164-55

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): John F. Acres et al.

Serial No.: 08/922,046

Examiner: J. Schaaf

Filing Date: September 2, 1997

Group Art Unit: 3744 3713

Title: **COMPUTER NETWORK FOR CONTROLLING AND MONITORING
GAMING DEVICES**

VIA HAND DELIVERY

Examiner J. Schaaf
Group Art Unit 3711
ASSISTANT COMMISSIONER OF PATENTS
Washington, D.C. 20231

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INFORMATION DISCLOSURE STATEMENT

The following documents were generated in a patent infringement civil action pending in the US District Court for the District of Nevada, *Mikohn Gaming Corporation v. Acres Gaming, Inc.*; *Acres Gaming, Inc. v. Mikohn Gaming Corporation*, New York, New York Hotel & Casino, LLC, *Casino Data Systems*, and *Sunset Station Hotel and Casino*, CV-S-97-1383 ("the civil action") and are submitted pursuant to 37 CFR 1.56:

Volume IA

- (a) Casino Data Systems and Sunset Station Hotel & Casino's ("CDS") Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882;
- (b) CDS' Memorandum of Points and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 [Filed *In Camera* - Subject to Protective Order];
- (c) CDS' Supplemental Brief Regarding CDS' First Motion for Summary Judgment of Invalidity;
- (d) CDS' Reply Memorandum in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent 5,752,882;

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Volume IB

- (e) Casino Data Systems and Sunset Station Hotel & Casino's Evidence in Support of CDS' Motion for Summary Judgment of Invalidity and Opposition to Acres' Motion for Preliminary Injunction ("CDS Exhibits") [Filed *In Camera* – Subject to Protective Order];

Volume II

- (f) Acres' Response to the Proposed Findings of Fact of Casino Data Systems Regarding CDS' Motion for Summary Judgment of Invalidity;
- (g) Acres Gaming, Inc.'s Opposition to Casino Data Systems' and Sunset Station Hotel and Casino's Motion for Summary Judgment;
- (h) Acres Gaming, Inc.'s Supplement to its Opposition to Casino Data Systems' and Sunset Station Hotel and Casino's Motion for Summary Judgment;
- (i) Acres Gaming, Inc.'s Second Supplement to its Opposition to Casino Data Systems' and Sunset Station Hotel and Casino's Motion for Summary Judgment;
- (j) Acres Gaming, Inc.'s Third Supplement to its Opposition to Casino Data Systems' and Sunset Station Hotel and Casino's Motion for Summary Judgment;

Volume III

- (k) Expert Report of W. Alan Jorgensen Pursuant to Federal Rule of Civil Procedure 26(a)(2);
- (l) Expert Report of Samuel Wolff Pursuant to Federal Rule of Civil Procedure 26(a)(2);
- (m) Transcript of Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 Before the Honorable Howard D. McKibben on January 19, 1999;


Volume IVA

- (n) Deposition of Disclosure, Inc. and Exhibits; and


Volume IVB


- (o) Additional Exhibits to deposition of Disclosure, Inc.

Volume IVB


10  — (o) Additional Exhibits to deposition of Disclosure, Inc.;

Volume V

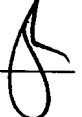
 — CDS' Third Motion and Memorandum of Points and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar);

 — Exhibits in Support of CDS' Third Motion and Memorandum of Points and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar);

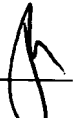
Volume VI


 — Acres Gaming's Opposition to CDS's Third Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar);

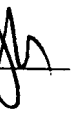
Volume VII

 — Deposition of Jose Vega Dated January 25, 1999 with Exhibit Nos. 191, 193, 194, 195, 197, 198;

Volume VIII


 — CDS Motion and Memorandum of Points and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* -- Subject to Protective Order];

 — Proposed Findings of Facts in Support of CDS' Memorandum of Points and Authorities in Support of CDS' Third Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* -- Subject to Protective Order]; and


 — Exhibits in Support of CDS' Motion and Memorandum of Points and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar), with Affidavit of Gregory C. Schodde [Filed *Under Seal* -- Subject to Protective Order]


Volume IX


 — Deposition of Derell M. Jones and Exhibits 618, 619 & 620


1  — Deposition of John F. Acres and Exhibits 706 (color copies), 709 & 715


Submitted with this Information Disclosure Statement (Not Bound)


 — Acres' Responses to CDS' Proposed Findings of Fact Regarding CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]


 — CDS' Reply Memorandum in Support of CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]


 — Acres Gaming's Opposition to CDS' Motion for Summary Judgment of Invalidity of U.S. Patent No. 5,752,882 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]


 — Acres' Responses to Proposed Findings of Fact of Casino Data Systems Regarding CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]

 — CDS' Reply Memorandum in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]


 — Proposed Findings of Fact in Support of CDS' Memorandum of Points and Authorities in Support of CDS' Third Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]


 — CDS' Motion and Memorandum of Point and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]

 — Acres Gaming's Opposition to CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]

 — Exhibits in Support of CDS' Memorandum of Point and Authorities in Support of CDS' Motion for Summary Judgment of Invalidity of US Patent No. 5,836,817 (On-Sale Bar) [Filed *Under Seal* – Subject to Protective Order]

Previously Submitted (Not Bound)

 — R. Stäuble, MPL 4215 Interface, October 1991, pgs. 1-16.

 — BYTE, Hardware/Software Showcase, December 1992, pg. 308.

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— Inder S. Gopal and Adrian Segall, IEEE Transactions on Communications,
 "Dynamic Address Assignment in Broadcast Networks," January 1986,
 Vol. Com-34, No. 1, pgs. 32-37.



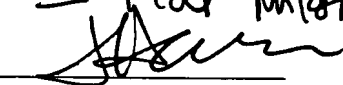
— Fred Swainston, A Systems Approach to Programmable Controllers,
 1992, pgs. ix-226.



— January 1993 product catalogue (Mitsubishi)



— 1989 Mitsubishi Super Controller Manual

Examiner: 

Date Considered: 4/24/2000

Acres Gaming, Inc. ("Acres"), the patentee in the civil action, is the assignee of the present application. In the list above, items in Volumes IA and IB are documents that were filed in support of a summary judgment motion by Casino Data Systems ("CDS"), the accused infringer in the civil action. The CDS motion contends that US Patent No. 5,752,882 ("the '882 patent") is invalid in view of a publication, namely Acres Gaming Incorporated Form SB-2 filed with the Securities and Exchange Commission on September 20, 1993 ("Form SB-2"), which is the only reference listed on the attached Form PTO-1449. Items in Volume II were filed by Acres in opposition to the CDS motion. Item (m) in Volume III is the transcript of the hearing on the CDS motion in which Judge Howard D. McKibben, the US District Court judge in the civil action, denied the CDS motion in a ruling from the bench. Items (k) and (l) in Volume III are the reports of experts retained by CDS, and Volumes IVA and IVB are a deposition, and accompanying exhibits, taken by CDS—all of which were generated in the civil action after denial of the CDS motion and in further support of CDS's position that Form SB-2 was published prior to the critical date for the '882 patent, namely October 12, 1993.

Because of a protective order entered in the civil action, Exhibits B, K, Y, and AA to item (e), Volume IB, are omitted as is Casino Data Systems and Sunset Station Hotel & Casino's Proposed Findings of Fact in Support of Casino Data Systems' Motion for Summary Judgement of Invalidity of U.S. Patent No. 5,752,882 [Filed *In Camera* – Subject to Protective Order]. In addition, item (b), Volume IA, is redacted in the same manner as it was published by CDS on the following web page: http://www.csds.com/PressRelease/LegalPres/Acres_dismissal.htm.

The present application and the '882 patent claim priority from the same grandparent application, namely Serial No. 322,172, filed October 12, 1994, now US Patent No. 5,655,961, and all of the applications share the same disclosure. The present application and the '882 patent therefore have the same October 12, 1993 critical date for the purpose of determining prior art.

Until now, Acres has not disclosed Form SB-2 in any of its pending applications in view of its belief that Form SB-2 was not published prior to the critical date and that even if it was, it did not affect patentability of any of the claims in its pending applications. Acres' belief is well supported in its enclosed opposition papers, particularly Volume II, item (g), pp. 12-16, and item (j). And Acres to this day believes that Form SB-2 was not published before the critical date in the '882 patent and that even if it was it would not affect patentability of the claims.

Acres' decision to make this disclosure even after denial of CDS's summary judgement motion is prompted in view of CDS's continued recent efforts--i.e., expert reports, Volume III items (k) and (l), received by Acres' attorneys on February 17, 1990, and the deposition of Disclosure, Inc., Volumes IVA and IVB, taken on February 25, 1999--to prove that Form SB-2 was published before the critical date.

Form SB-2 is attached as Exhibit T to item (e), in Volume IB. CDS's view of its relevance is set forth on pages 10-11 of item (b), in Volume IA. But even if Form SB-2 is considered to have been published before the critical date, it still does not affect patentability of any of the issued or pending Acres' claims, including those in the present application. As set forth in the Acres opposition papers--particularly Volume II, item (g), pp. 12-16, and item (j)--Form SB-2 does not disclose the invention nor does it enable a person with ordinary skill in the art to make and use it.

Applicant requests that the Examiner review the information submitted with this document and issue a notice of allowability.

Respectfully submitted,



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